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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,974	10/28/2003	Lang H. Nguyen	03090	4437
7590 Robert J. Follett, Esq. CABOT CORPORATION Law Department 157 Concord Road Billerica, MA 01821			EXAMINER RONESI, VICKEY M	
			ART UNIT	PAPER NUMBER
			1714	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/07/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/694,974

Applicant(s)

NGUYEN, LANG H.

Examiner

Vickey Ronesi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21,24-34 and 37-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21,24-34 and 37-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/9/2006 has been entered.
2. All outstanding objections and rejections are withdrawn in light of applicant's amendment filed on 11/9/2006.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

### *Claim Rejections - 35 USC § 103*

4. Claims 21, 24-34, and 37-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams et al (US 5,698,016).

Adams et al discloses compositions of modified carbon products, wherein a modified carbon product is functionalized with an organic group that is preferably an ionic group, an ionizable group, or a mixture thereof (col. 5, line 28 to col. 6, line 13) including carboxyphenyl and sulfophenyl groups and is dispersed and associates with an anionic amphiphilic ions such as preferred sodium bis(2-ethylhexyl) sulfosuccinate and a homo- or copolymer of acrylic acid or methacrylic acid or salts thereof (col. 2, lines 37-44) (wherein the use of ammonium salts is

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common) in the most preferred of mediums, water (col. 4, lines 46-49). The modified carbon product composition is incorporated into various formulations such as inks and coatings. In particular, the compositions are used in non-aqueous coating compositions including acrylic, urethane, and epoxy resins (col. 8, lines 22-50) and solvents such as aromatic hydrocarbons(col. 8, lines 33-37), e.g., xylene (Example 17, col. 19, line 32).

While Adams et al does not exemplify or explicitly disclose the use of two anionic amphiphilic ions, it is considered that it would have been well within the capabilities of one of ordinary skill in the art to use two ingredients which are known to impart the same effect. It is well settled that it is *prima facie* obvious to combine two ingredients, each of which is targeted by the prior art to be useful for the same purpose. *In re Lindner* 457 F,2d 506,509, 173 USPQ 356, 359 (CCPA 1972). Applicant's allegation of unexpected results is acknowledged, however, the examples given do not support unexpected results. In particular, the examples are not proper side-by-side examples since it is not made known how exactly the pigment of the inventive examples differs from the comparative examples. In particular, it is not even made clear if the comparative pigments were even subject to a dispersant and, if so, what kind. Moreover, a significant improvement in properties has not been clearly established since no statistical measurements have been given and therefore it is not possible to gauge, for example, whether (with respect to  $M_c$  value) 313 (Ex. 4) is indeed considerably higher than 307 (Comp. 7).

### ***Response to Arguments***

5. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

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*Conclusion*

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

2/2/2007

Vickey Ronesi



  
VASU JAGANNATHAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700